

REMARKS

Applicant has carefully reviewed the Office Action of April 28, 2005, and offers the following remarks to accompany the above amendments.

Initially, Applicant amends claims 1, 14, and 27 to include the subject matter of 9, 22, and 35 respectively. Claims 9, 22, and 35 are canceled as redundant. Claims 10, 23, and 36 are amended to correct their dependency in light of the cancellation of claims 9, 22, and 35. Claims 1, 11, 14, 24, 27 and 37 are also amended to correct antecedent basis. No new matter is added.

Claims 1-3, 5, 6, 11, 14-16, 18, 19, 24, 27-29, 31, 32, and 37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Gudjonsson (hereinafter "Gud"). The amendments to claims 1, 14, and 27 moot this rejection. Applicant will address the amended claims under the next rejection heading.

Claims 4, 7-10, 12, 17, 20-23, 25, 30, 33-36, and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Gud in view of Kimchi et al. (hereinafter "Kimchi"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness analysis, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). While the range of available sources to support an articulated motivation is broad, the breadth of the range does not diminish the requirement for actual evidence. *Id.* If the Patent Office has not provided the requisite evidentiary support, the combination is improper, and a rejection based on such a combination is improper.

Furthermore, to establish *prima facie* obviousness, the Patent Office must show where each and every element is taught or suggested in the combination. MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

As Applicant has amended claims 1, 14, and 27 to include the subject matter of claims 9, 22, and 35, this rejection is now applicable to the amended independent claims. The Patent Office admits that Gud does not show the element recited in claims 9, 14, and 22, but asserts that Kimchi shows this element in paragraph 0044. The Patent Office does not provide any analysis in its examination of claim 9 for why Gud would be combined with Kimchi. Rather, in its analysis of claim 4, the Patent Office asserts that the motivation to combine Gud and Kimchi "is that Kimchi system's ability to combine (via software) physical devices gives the combination a

communication ability that is not afforded by individual devices alone. For example, a video input device and phone allows one to use a virtual videophone.” (Office Action of April 28, 2005, page 7, lines 16-18). This asserted motivation lacks the requisite evidentiary support required by the Federal Circuit. While the Patent Office proposes an example to support the motivation, the example is not actual evidence. The Federal Circuit is quite clear that the Patent Office must use actual evidence in support of the motivation to combine references or the motivation is improper. Since the Patent Office has not supported the motivation to combine the references, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejections based on the combination are improper, and the claims are allowable.

Claims 10, 23, and 36 deserve separate mention. Claims 10, 23, and 36 recite “provide a single address for each of the plurality of devices in the user domain. . .”, or some permutation of this element. The Patent Office asserts that this element is taught in Kimchi paragraph 0042. Applicant respectfully traverses this assertion. Kimchi paragraph 0042 talks about a single transport address for a terminal device. Each terminal device has its own address. Multiple terminal devices are registered and then assembled into the virtual device, which has all the addresses associated with the original terminal devices. There is nothing in the passage that indicates that the terminal server has a single address. Since the Patent Office asserts that the terminal server is analogous to Applicant’s user agent, and the terminal server clearly does not have a single address, Kimchi does not teach or suggest the claim element. Since Gud admittedly does not teach or suggest the claim element, and Kimchi demonstrably does not teach or suggest the claim element, the combination of references does not teach or suggest the claim element. Since the combination of references does not teach or suggest the claim element, the combination does not establish *prima facie* obviousness, and claims 10, 23, and 36 are allowable for this reason as well.

Claims 13, 26, and 39 were rejected under 35 U.S.C. § 103 as being unpatentable over Gud. Applicant respectfully traverses. As explained above, the amendments to claims 1, 14, and 27 to include the subject matter of claims 9, 22, and 35 effectively moots this rejection. The Patent Office admits that Gud does not teach the elements of original claims 9, 22, and 35 and thus, Gud does not render amended claims 1, 14, and 27 obvious. Applicant requests withdrawal of the § 103 rejection of claims 13, 26, and 39 at this time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. The references of record are not properly combinable based on the Patent Office's failure to provide evidence to support the motivation to combine the references. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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